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08/609,517 03/01/96 PINSKY

H ARC-001CN2(7)

EXAMINER

MCLEHENY JR. D

ART UNIT

PAPER NUMBER

3

24M1/0809

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2411

DATE MAILED:

08/09/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ \_\_\_\_\_

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1 - 18 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 1 - 18 are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

**EXAMINER'S ACTION**



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1. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

2. Claims 1-18 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-18 of prior U.S. Patent No. 5,469,353. This is a double patenting rejection.

These claims are in essence the same invention and claims acted upon which resulted in the grant of U.S. Patent No. 5,469,353, with the exception being only of minor inconsequential grammatical wording. While the instant application's claims are not exactly identical in words, they are identical as to the steps, structure and claimed features covered because they map out to the same identical disclosed elements and algorithmic steps in the written disclosure and figures. Such is an

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inappropriate matter for consideration in a continuation or

~~divisional type application in view of the fact the application~~



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and the patent are drawn to the same inventive subject matter and would result in a grant to second patent thereon, leaving unanswered any errors why applicants failed to properly prosecute the same invention in the parent patent's application. Proper course of action for reconsideration of such claims should have been a Reissue or a Reexamination type application. Applicants possibly have a file wrapper estoppel history existing in the parent application which effects resubmission of identical or similar claims in the instant application.

3. Applicants' IDS statement dated 5/20/96 has been received.

However, other considerations of prior art than that applied above will not be considered and are inappropriate in the instant application.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald McElheny Jr., whose telephone number is (703) 305-3894.

Fax transmissions may be directed to (703) 305-9564 or 305-9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.



**DONALD E. McELHENY, JR.**  
**PRIMARY EXAMINER**  
**GROUP 2400**